

REMARKS

In the non-final Office Action, the Examiner withdrew claims 18-26 and 52-60 from further consideration; rejected claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. (U.S. Patent No. 5,579,379) in view of Riggins (U.S. Patent No. 6,766,454); rejected claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins and Faccinn et al. (U.S. Patent Application Publication No. 2002/0127995); rejected claims 15-17 and 64 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins and Innes (U.S. Patent No. 6,687,743) or Hesselink et al. (U.S. Patent No. 6,499,054) or Eastman (U.S. Patent No. 6,907,032); rejected claims 30 and 33 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins, Faccinn et al., and Fletcher et al. (U.S. Statutory Invention Registration No. H1,897); rejected claims 38-42 and 66-68 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Innes or Hesselink et al. or Eastman and Faccinn et al.; rejected claims 66-68 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Innes; rejected claims 43, 44, 47-51, and 79 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Jordan (U.S. Patent Application Publication No. 2001/0050984) and Hluchyj et al. (U.S. Patent No. 6,282,193); and rejected claims 45 and 46 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Jordan, Hluchyj et al., and Faccinn et al.

By this Amendment, Applicants amend claims 1, 27, 28, 31, 43, and 61 to improve form. Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103. Claims 1-64, 66-68, and 75-80 remain pending, of which claims 18-26 and 52-60 have been withdrawn from consideration by the Examiner.

IMPROPER RESTRICTION REQUIREMENT

In paragraph 1 of the Office Action, the Examiner withdrew claims 18-26 and 52-60 from further consideration as being drawn to a non-elected species. Applicants traversed the restriction requirement in Applicants' response to the restriction requirement. The Examiner nevertheless maintained the restriction. Applicants respectfully request rejoinder of the withdrawn claims upon the indication of allowable subject matter.

REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL. AND RIGGINS

In paragraph 3 of the Office Action, the Examiner rejected claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins. Applicants respectfully traverse the rejection.

Amended independent claim 1, for example, is directed to a method for placing a call between a first client and a second client. The method comprises receiving a call request message; challenging a device that originated the call request message to authenticate itself, whereby the device performs a first authentication process based on a username and a password associated with the device to generate a first authentication result as a result of authenticating itself; authenticating the call request message by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result to the first authentication result, whereby an authentic originating client is identified; and searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client

billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained.

Neither D'Amico et al. nor Riggins, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 1. For example, D'Amico et al. and Riggins do not disclose or suggest searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained.

The Examiner alleged that D'Amico et al. discloses searching a database to find a predetermined client billing tag and cited column 27, line 57 - column 29, line 45, of D'Amico et al. for support (Office Action, page 2). Applicants respectfully submit that D'Amico et al. does not disclose or suggest searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained, as required by claim 1.

D'Amico et al. is directed to the problem of undesirable calls to cellular phone subscribers who are outside the range of their home base station and, therefore, subject to pay for all incoming calls (col. 8, lines 44-52). D'Amico et al. discloses a caller pays feature, whereby a calling party is prompted to indicate whether they wish to pay cellular air time charges necessary to complete a call to the cellular phone subscriber (col. 8, lines 53-67).

At column 27, line 57 - column 29, line 45, D'Amico et al. discloses that it is determined whether automatic number identification (ANI) can be determined for a received call (col. 27, lines 57-61). If the ANI can be determined, it is determined whether the ANI corresponds to an entry in a VIP table (col. 28, lines 1-7). If the ANI corresponds to an entry in the VIP table, then the call is established and the called party is charged for the cellular air time charges (col. 28, lines 1-7). If the ANI does not correspond to an entry in the VIP table, then a message is played for the calling party indicating that, to complete the call, the calling party must pay for the cellular air time charges (col. 28, lines 30-34). Upon refusal to accept the charges, the call is routed to voicemail (col. 28, lines 40-44). Upon agreement to accept the charges, a record is created based on the ANI (col. 28, lines 48-60). If the ANI cannot be determined, a message is played for the calling party requesting a PIN (the called party may provide PINs to calling parties who are not required to pay the cellular air time charges) (col. 28, line 61 - col. 29, line 4). If the calling party provides a proper PIN, the call is established and the called party is charged for the cellular air time charges (col. 29, lines 5-10). As an alternative to the PIN or if the calling party provides an incorrect PIN, a message can be presented to the calling party requesting entry of a credit card number to which to bill the cellular air time charges for the call (col. 29, lines 14-18).

Nowhere in this section, or elsewhere, does D'Amico et al. disclose or remotely suggest searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained, as required by claim 1. In other words, D'Amico et al. does not disclose or suggest searching a database to find a predetermined client billing tag that

identifies the calling party (which the Examiner equated to the authentic originating client) as a party responsible for the call, authorizing the call if the client billing tag is obtained, and not authorizing the call if the client billing tag is not obtained. Riggins also does not disclose these features.

The Examiner alleged that the numbers stored in the VIP list of D'Amico et al. are equivalent to client billing tags (Office Action, page 16). The Examiner alleged that D'Amico et al. discloses that if the number of the calling party is listed in the VIP table, then the call is put through and the called party is charged, and if the number of the calling party is not listed in the VIP table, then the call is routed to voice mail or terminated (Office Action, pages 16-17). Regardless of the accuracy of the Examiner's allegations, Applicants submit that the numbers in the VIP table do not identify the calling party (which the Examiner equated to the authentic originating client) as the party responsible for paying for the call, as required by claim 1. Instead, D'Amico et al. specifically discloses that if the number of the calling party is listed in the VIP table, then the call is put through and the called party will pay for the cellular air time (col. 28, lines 1-7). Therefore, contrary to the Examiner's allegations, the numbers in the VIP table of D'Amico et al. cannot be equated to the client billing tag recited in claim 1.

Further, the Examiner relied upon Riggins as disclosing challenging a device and authenticating the call request message features of claim 1 (Office Action, page 3). The Examiner alleged that it would have been obvious to one of ordinary skill to include the teaching of Riggins in D'Amico et al. for the purpose of securing access to services in a computer network (Office Action, page 3). Applicants respectfully submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 1.

It is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Riggins and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. is directed to the field of cellular communication (col. 8, lines 14-52). Riggins is directed to the non-analogous field of computer networks (col. 1, lines 25-27). Further, D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with secure access to services in a computer network. Therefore, contrary to the Examiner's allegation, combining the disclosure of challenging and authenticating a device, as allegedly disclosed by Riggins, into the cellular communications system of D'Amico et al. would not transform the D'Amico et al. cellular communications system into one with secure access to services in a computer network. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

The Examiner further alleged that since the combination was for a method of security and not the specifics of the network, the motivation is clearly relevant (Office Action, page 17). The Examiner's allegation is insufficient to cure the deficiencies in the Examiner's motivation statement. The Examiner still has not provided a reasonable explanation of why one of ordinary skill in the art with knowledge of the cellular communications system of D'Amico et al. would

look to secure access to services in a computer network. Accordingly, the Examiner's motivation statement still falls short of establishing a prima facie case of obviousness.

For at least these reasons, Applicants submit that claim 1 is patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination. Claims 4, 5, 9, 10, and 75 depend from claim 1 and are, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination.¹ Claims 4, 5, 9, 10, 18-26, and 75 are also patentable for reasons of their own.

For example, claim 75 recites receiving the username and the first authentication result from the device, determining a password that corresponds to the username, performing a hash function based on the username and password, and determining whether a result of the hash function matches the first authentication result.

Neither D'Amico et al. nor Riggins, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 75. For example, D'Amico et al. and Riggins do not disclose or suggest performing a hash function based on the username and password. D'Amico et al. discloses nothing remotely similar to this feature. Riggins discloses using challenge 965 and a registered hash of the user's password to perform a one-way hash (col. 14, lines 19-22). Riggins does not disclose or suggest performing a hash function based on a username and password, as required by claim 75.

The Examiner alleged that Riggins discloses that the global server 920 may retrieve and use user's information 960 such as the user's password, a hash of the user's password, or the

¹ As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

user's public key (Office Action, pages 18-19). Nowhere does Riggins disclose or suggest performing a hash function based on a username and password, as required by claim 75. The Examiner only alleged that Riggins discloses using a hash of the user's password (Office Action, pages 18-19). Therefore, the Examiner has not addressed the features of claim 75 and has not established a prima facie case of obviousness with regard to claim 75.

For at least these additional reasons, Applicants submit that claim 75 is patentable of D'Amico et al. and Riggins, whether taken alone or in any reasonable combination.

Amended independent claim 61 recites features similar to, but possibly different in scope from, features recited in claim 1. Claim 61 is, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 1. Claim 80 depends from claim 61 and is, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 61. Claim 80 also recites features similar to features recited in claim 75. Claim 80 is, therefore, also patentable over D'Amico et al. and Riggins for at least reasons similar to reasons given with regard to claim 75.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) based on D'Amico et al. and Riggins.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, AND FACCINN ET AL.*

In paragraph 4 of the Office Action, the Examiner rejected claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) as allegedly unpatentable over

D'Amico et al. in view of Riggins and Faccinn et al. Applicants respectfully traverse the rejection.

Claims 2, 3, 6-8, and 11-14 depend from claim 1. Without acquiescing in the Examiner's rejection with regard to claims 2, 3, 6-8, and 11-14, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claim 1. Claims 2, 3, 6-8, and 11-14 are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 1.

Amended independent claim 27 is directed to a computer readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The method comprises receiving a call request message; challenging a device that originated the call request message to authenticate itself, whereby the device generates an authentication result as a result of authenticating itself; authenticating the call request message based on the authentication result, whereby an authentic originating client is identified; searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained; inserting the client billing tag into the call request message; and forwarding the call request message with the inserted client billing tag.

Neither D'Amico et al., Riggins, nor Faccinn et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 27. For example, neither D'Amico et al., Riggins, nor Faccinn et al. discloses or suggests searching a

database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained.

The Examiner alleged that D'Amico et al. discloses searching a database to find a predetermined client billing tag and cited column 27, line 57 - column 29, line 45, of D'Amico et al. for support (Office Action, page 4). Applicants respectfully submit that D'Amico et al. does not disclose or suggest searching a database to find a predetermined client billing tag that identifies the authentic originating client as a party responsible for paying for the call, whereby the call is authorized to be completed if the client billing tag is obtained, and the call is not authorized to be completed if the client billing tag is not obtained, as required by claim 27, for at least reasons similar to reasons given with regard to claim 1.

Further, the Examiner relied upon Riggins as allegedly disclosing challenging a device and authenticating the call request message features of claim 27 (Office Action, pages 4-5). The Examiner alleged that it would have been obvious to one of ordinary skill to include the teaching of Riggins in D'Amico et al. for the purpose of securing access to services in a computer network (Office Action, page 5). Applicants respectfully submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 27 for at least reasons similar to reasons given with regard to claim 1.

Moreover, the Examiner relied upon Faccinn et al. as allegedly disclosing inserting a client billing tag into a call request message, as recited in claim 27 (Office Action, page 5). The Examiner alleged that it would have been obvious to one of ordinary skill to include the

teachings of Faccinn et al. in D'Amico et al. for the purpose of billing IP based telephone calls (Office Action, page 5). Applicants respectfully submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 27.

As stated above, it is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Faccinn et al. and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with IP based telephone calls. Therefore, contrary to the Examiner's allegation, combining the disclosure of inserting a client billing tag into a call request message, as allegedly disclosed by Faccinn et al., into the cellular communications system of D'Amico et al. would not facilitate billing of IP based telephone calls in the D'Amico et al. cellular communications system. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

The Examiner further alleged that D'Amico et al. discloses "regular billing methods" and Faccinn et al. discloses "billing of IP type calls" and the disclosure of Faccinn et al. would allow for billing of IP type calls in the D'Amico et al. system (Office Action, page 19). Applicants submit that the Examiner's allegation lacks merit. As explained above, D'Amico et al. has absolutely nothing to do with IP based telephone calls. The Examiner has provided no

reasonable explanation of why one of ordinary skill would seek to allow for the billing of IP type calls in the D'Amico et al. system. Accordingly, the Examiner's motivation statement still falls short of establishing a prima facie case of obviousness.

For at least these reasons, Applicants submit that claim 27 is patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination. Claim 76 depends from claim 27 and is, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 27. Claim 76 also recites features similar to features recited in claim 75. The disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claim 75. Therefore, claim 76 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 75.

Amended independent claim 28 recites features similar to, but possibly different in scope from, features recited in claim 27. Claim 28 is, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 27. Claims 29 and 77 depend from claim 28 and are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 28. Claim 77 also recites features similar to features recited in claim 76. Therefore, claim 77 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 76.

Amended independent claim 31 is directed to a computer readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The method comprises receiving a SIP call request message from the first

client; challenging a device that originated the SIP call request message to authenticate itself, whereby the device generates an authentication result as a result of authenticating itself; evaluating at least one calling feature in a profile of the second client; determining an authentic originating client based on the at least one calling feature and the authentication result; retrieving a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; and inserting the client billing tag into the SIP call request message.

Neither D'Amico et al., Riggins, nor Faccinn et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 31. For example, D'Amico et al., Riggins, and Faccinn et al. do not disclose or suggest retrieving a client billing tag that identifies the authentic originating client as a party responsible for paying for the call, for at least reasons similar to reasons given with regard to claim 27.

For at least these reasons and reasons similar to reasons given with regard to the other independent claims, Applicants submit that claim 31 is patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination. Claims 32, 34-37, and 78 depend from claim 31 and are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 31. Claim 78 also recites features similar to features recited in claim 76. Therefore, claim 78 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 76.

Claims 62 and 63 depend from claim 61. Without acquiescing in the Examiner's rejection with regard to claims 62 and 63, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claim 61. Claims 62 and 63 are, therefore, patentable over

D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 61.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, and Faccinn et al.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, AND INNES, HESELINK ET AL., OR EASTMAN*

In paragraph 5 of the Office Action, the Examiner rejected claims 15-17 and 64 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins and Innes, Hesselink et al., or Eastman. Applicants respectfully traverse the rejection.

Claims 15-17 depend from claim 1, and claim 64 depends from claim 61. Without acquiescing in the Examiner's rejection with regard to claims 15-17 and 64, Applicants respectfully submit that the disclosures of Innes, Hesselink et al., and Eastman do not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claims 1 and 61. Therefore, claims 15-17 and 64 are patentable over D'Amico et al., Riggins, and Innes, Hesselink et al., or Eastman, whether taken alone or in any reasonable combination, for at least the reasons given with regard to claims 1 and 61.

Moreover, the Examiner alleged that Hesselink et al. and Eastman disclose only one of the features recited in claims 15 and 64 and none of the features recited in claims 16 and 17 (Office Action, page 7). Therefore, the Examiner did not establish a prima facie case of obviousness with regard to claims 15-17 and 64 based on either Hesselink et al. or Eastman.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-17 and 64 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, and Innes, Hesselink et al., or Eastman.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, FACCINN ET AL., AND FLETCHER ET AL.*

In paragraph 6 of the Office Action, the Examiner rejected claims 30 and 33 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins, Faccinn et al., and Fletcher et al. Applicants respectfully traverse the rejection.

Claim 30 depends on claim 28, and claim 33 depends on claim 31. Without acquiescing in the Examiner's rejection with regard to claims 30 and 33, Applicants respectfully submit that the disclosure of Fletcher et al. does not cure the deficiencies in the disclosures of D'Amico et al., Riggins, and Faccinn et al. identified above with regard to claims 28 and 31. Therefore, claims 30 and 33 are patentable over D'Amico et al., Riggins, Faccinn et al., and Fletcher et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claims 28 and 31.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 30 and 33 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, Faccinn et al., and Fletcher et al.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL.,
INNES, HESELINK ET AL., OR EASTMAN, AND FACCINN ET AL.*

In paragraph 7 of the Office Action, the Examiner rejected claims 38-42 and 66-68 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Innes, Hesselink et al., or Eastman, and Faccinn et al. Applicants respectfully traverse the rejection.

Independent claim 38, for example, is directed to a computer readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The method comprises receiving a SIP call request message; adding a header to the SIP call request message, the header including a server identifier to identify a server sending the SIP call request message; and transmitting the SIP call request message and the header to a network gateway.

The Examiner alleged that Faccinn et al. discloses receiving a SIP call request message (Office Action, page 10). The Examiner alleged that it would have been obvious to use the SIP protocol with call request messages in the systems of D'Amico et al. and Innes, Hesselink et al., or Eastman because "doing so would have been to allow for joint billing for GPRS services and IP telephony services" (Office Action, page 10). Applicants submit that the Examiner's allegation lacks merit.

D'Amico et al. and Innes, Hesselink et al., or Eastman do not even mention SIP. The Examiner has not provided any reasonable explanation of how to implement the SIP protocol in the D'Amico et al. system, why simply implementing the SIP protocol in the D'Amico et al. system would permit the alleged benefit of joint billing for GPRS services and IP telephony services, or why one of ordinary skill would seeking to obtain the alleged benefit of joint billing for GPRS services and IP telephony services in the D'Amico et al. system. Therefore, the Examiner's allegation falls short of establishing a prima facie case of obviousness with regard to claim 38.

For at least these reasons, Applicants submit that claim 38 is patentable of D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable

combination. Claim 39 depends from claim 38 and is, therefore, patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al. for at least the reasons given with regard to claim 38.

Independent claim 40 is directed to a computer readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The method comprises receiving a call request message; checking the call request message for a server identifier in a security header appended to the call request message, the server identifier identifying a server that forwarded the call request message; and completing the call based on existence of the server identifier in the security header.

D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination, do not disclose or suggest the combination of features recited in claim 40. The Examiner relied on Innes for allegedly disclosing adding a header to a call request message where the header includes a server identifier and transmitting the call request message to client equipment, where the client equipment is configured to complete the call (return call) if the header is detected (Office Action, page 9). The Examiner alleged that it would have been obvious to include the teachings of Innes in D'Amico et al. for the purpose of establishing a server initiated high level protocol communications session between a server and a client on a mobile computing device (Office Action, page 9). Applicants respectfully submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 40.

As stated above, it is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection

must provide a reasonable explanation of why one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Innes and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with server initiated high level protocol communications sessions. Therefore, contrary to the Examiner's allegation, combining the disclosure of adding a header to a call request message where the header includes a server identifier and transmitting the call request message to a client equipment, where the client equipment is configured to complete the call (return call) if the header is detected, as allegedly disclosed by Innes, into the cellular communications system of D'Amico et al. would not cause the D'Amico et al. cellular communications system to establish a server initiated high level protocol communications session between a server and a client on a mobile computing device. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

With regard to Hesselink et al. and Eastman, the Examiner admitted that D'Amico et al. does not disclose or suggest adding a header to a call request message and completing the call if the header is detected (Office Action, page 9). The Examiner alleged that Hesselink et al. and Eastman disclose adding a header to a call request message (Office Action, pages 9-10). The Examiner did not provide any evidence that either Hesselink et al. or Eastman discloses or suggests completing the call based on existence of the server identifier in a security header, as

required by claim 40. Therefore, the Examiner did not establish a prima facie case of obviousness with regard to claim 40 based on either Hesselink et al. or Eastman.

The Examiner relied on Faccinn et al. for allegedly disclosing receiving a SIP call request message (Office Action, page 10). Claim 40 does not recite receiving a SIP call request message. Therefore, it is unclear as to what part of claim 40 the Examiner believes is allegedly disclosed by Faccinn et al. Accordingly, the current rejection set forth by the Examiner is improper.

For at least these reasons, Applicants submit that claim 40 is patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination. Claims 41 and 42 depend from claim 40 and are, therefore, patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al. for at least the reasons given with regard to claim 40.

Independent claim 66 recites features similar to, but possibly different in scope from, features recited in claim 40. Claim 66 is, therefore, patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 40. Claims 67 and 68 depend from claim 66 and are, therefore, patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al. for at least the reasons given with regard to claim 66.

The Examiner did not address the features of claims 66-68 and, therefore, did not establish a prima facie case of obviousness with regard to claims 66-68.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 38-42 and 66-68 under 35 U.S.C. § 103(a) based on D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al.

REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL. AND INNES

In paragraph 8 of the Office Action, the Examiner rejected claims 66-68 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Innes. Applicants respectfully traverse the rejection.

Independent claim 66 is directed to a network gateway system for placing a call between a first client and a second client. The system comprises a communications interface for establishing a call with a circuit switched network; and a processor coupled to the communications interface, the processor being programmed to receive a call request message, check the call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, and complete the call based on the existence of the security header including the server identifier.

D'Amico et al. and Innes, whether taken alone or in any reasonable combination, do not disclose or suggest the combination of features recited in claim 66. D'Amico et al. and Innes do not disclose or suggest a processor to check the call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message.

The Examiner did not address these features of claim 66. Instead, the Examiner alleged that Innes discloses adding a header to a call request header, where the header includes a server

identifier to identify a server sending the call request message and cited column 2, lines 5-16, column 2, line 60 - column 3, line 4, column 9, lines 36-56, and claims 4, 14, and 20 of Innes for support (Office Action, page 11). Irrespective of the Examiner's allegation, Applicants submit that Innes does not disclose or suggest a processor to check the call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, as recited in claim 66.

At column 2, lines 5-16, Innes discloses:

Accordingly, the present invention provides a method for establishing a server initiated high-level protocol communications session between a server and a client on a mobile computing device, wherein said mobile computing device supports a low-level protocol for both inbound and outbound calls, and a high-level protocol for outbound calls only, said method comprising the steps of: initiating a first call from said server to said client using the low-level protocol; responsive to detecting said first call at the client, initiating a second call from said client to said server; and responsive to receiving the second call at the server, establishing said communications session.

In this section, Innes discloses initiating a first call from a server to a client using a low-level protocol; responsive to detecting the first call at the client, initiating a second call from the client to the server; and responsive to receiving the second call at the server, establishing a communications session. Nowhere in this section, or elsewhere, does Innes disclose or suggest a processor to check a call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, as required by claim 66.

At column 2, line 60 - column 3, line 4, Innes discloses:

Note that several variations are possible on the form and handling of the initial call from the server to the client. One possibility is to use SMS messaging, a feature of many mobile telephone networks, as the low level protocol. This is generally supported natively by many mobile devices. Another possibility is to use network communication protocols at the client as the low-level protocol to detect the caller id of the server. Thus if the first call is determined as originating from

a particular server based on the caller id (whether or not the mobile device actually answers the call itself) this can then be used to trigger an outbound call back from the client to the server.

In this section, Innes discloses that if a client determines that a call originates from a particular server based on the caller id of the server, then it initiates a call from the client to the server.

Nowhere in this section, or elsewhere, does Innes disclose or suggest a processor to check a call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, as required by claim 66. Even if the first call disclosed by Innes could be equated to a call request message (a point that Applicants do not concede), Innes does not disclose or suggest checking the first call for the existence of a security header appended to the first call, as would be required by claim 66. In other words, nowhere does Innes disclose or remotely suggest something equivalent to a security header that may or may not be appended to a call request message. Instead, Innes suggests that if the client recognizes the caller id associated with the first call as being associated with a particular server, then the client places a call to the server (col. 2, line 65 - col. 3, line 4).

At column 9, lines 36-56, Innes discloses:

Although the preferred embodiment uses a specific keyword in the trigger message to prompt the outbound call from the PDA to the server, there are many other possibilities, such as using caller id from the server. Thus if the number of a known server is recognised with respect to an incoming call, then this could directly trigger the return call from the client to the server (and potentially also the mailbox synchronisation), irrespective of whether the initial call is actually answered at the PDA. Alternatively, the server might use an SMS message to the PDA as the trigger message. This has the added advantage that such a message will be queued if the PDA is switched off for future delivery. It will be appreciated that both of these approaches are possible independent of whether the mail or travel server contacts the PDA directly, or whether the message server is used as an intermediary. Note however that the communication with the client via a basic serial protocol as in the preferred embodiment implies the solution is not limited to a specific infrastructure, unlike GSM SMS messages or caller id in most situations, and so can work internationally.

In this section, Innes discloses that if a client recognizes the number of a known server with respect to an incoming call, then this could directly trigger the return call from the client to the server. Nowhere in this section, or elsewhere, does Innes disclose or suggest a processor to check a call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, as required by claim 66, for at least the reasons given above.

Claims 4, 14, and 20 of Innes also do not disclose or suggest a processor to check a call request message for existence of a security header appended to the call request message, the security header including a server identifier identifying a server that forwarded the call request message, as required by claim 66.

D'Amico et al. and Innes also do not disclose or suggest a processor to complete the call based on the existence of the security header including the server identifier, as further recited in claim 66. The Examiner alleged that Innes discloses that the client is configured to complete the call (return call) if the header is detected and inherently not complete the call if the header is not detected (Office Action, page 11). Applicants disagree.

Innes does not disclose or remotely suggest completing a call. Instead, Innes specifically discloses that the client initiates a new call when the caller id of a known server is not recognized with respect to an incoming call (col. 9, lines 39-44). Therefore Innes does not disclose or suggest a processor to complete the call based on the existence of the security header including the server identifier, as required by claim 66.

The Examiner alleged that it would have been obvious to include the teachings of Innes in D'Amico et al. for the purpose of establishing a server initiated high level protocol

communications session between a server and a client on a mobile computing device (Office Action, page 11). Applicants respectfully submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 66.

As stated above, it is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Innes and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with server initiated high level protocol communications sessions. Therefore, contrary to the Examiner's allegation, combining the disclosure of adding a header to a call request message where the header includes a server identifier and transmitting the call request message to a client equipment, where the client equipment is configured to complete the call (return call) if the header is detected, as allegedly disclosed by Innes, into the cellular communications system of D'Amico et al. would not cause the D'Amico et al. cellular communications system to establish a server initiated high level protocol communications session between a server and a client on a mobile computing device. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

For at least these reasons, Applicants submit that claim 66 is patentable of D'Amico et al. and Innes, whether taken alone or in any reasonable combination. Claims 67 and 68 depend

from claim 66 and are, therefore, patentable over D'Amico et al. and Innes for at least the reasons given with regard to claim 66.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 66-68 under 35 U.S.C. § 103(a) based on D'Amico et al. and Innes.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., JORDAN, AND HLUCHYJ ET AL.*

In paragraph 9 of the Office Action, the Examiner rejected claims 43, 44, 47-51, and 79 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Jordan and Hluchyj et al. Applicants respectfully traverse the rejection.

Amended independent claim 43 is directed to a system for placing a call between a first client and a second client. The system comprises a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, whereby the device performs a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, process a SIP call request message received from the first client to determine an authentic originating client by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result with the first authentication result, obtain a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; and a network gateway coupled to the SIP server, the network gateway being configured to provide at least one of the first client or the second client conditional access to a public switched telephone network.

Neither D'Amico et al., Jordan, nor Hluchyj et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 43.

For example, D'Amico et al., Jordan, and Hluchyj et al. do not disclose or suggest a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, whereby the device performs a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, or process a SIP call request message received from the first client to determine an authentic originating client by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result with the first authentication result.

The Examiner alleged that Jordan discloses these features and cited paragraphs 0035-0052 of Jordan for support (Office Action, page 12). Applicants respectfully disagree.

At paragraphs 0035-0052, Jordan discloses that an ISN authenticates call initiation equipment by sending it a validation request that includes a random number (paragraph 0038). The call initiation equipment performs a one-way hashing function on the random number to generate an authentication identification number that it returns along with a customer wireline identification number (paragraphs 0042 and 0043). The ISN compares the authentication identification number with its own authentication data (paragraph 0047). Nowhere does Jordan disclose or suggest a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, whereby the device performs a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, or process a SIP call request message received from the first client to determine an authentic originating client by performing a second authentication process based on the username and the password associated with the device to

generate a second authentication result and comparing the second authentication result with the first authentication result, as required by claim 43.

The Examiner alleged that this argument does not comply with 37 CFR 1.11(c) because it allegedly does not clearly point out the patentable novelty which Applicants believe the claims present in view of the state of the art disclosed by the references cited, and it allegedly does not show how the amendments avoid such references (Office Action, page 21). Applicants submit that the Examiner's allegation lacks merit and appears to be an attempt to cure the Examiner's failure to establish a prima facie case of obviousness by attempting to shift the burden to Applicants. Applicants have clearly explained what features of Applicants' claim 43 are not disclosed or suggested by the cited references. For example, as explained above, Jordan does not disclose (and neither do any of the other references for that matter) a first authentication process that is performed based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, or a second authentication process performed based on the username and the password associated with the device to generate a second authentication result, as required by claim 43.

For at least these reasons, claim 43 is patentable over D'Amico et al., Jordan, and Hluchyj et al., whether taken alone or in any reasonable combination. Claims 44, 47-51, and 79 depend from claim 43 and are, therefore, patentable over D'Amico et al., Jordan, and Hluchyj et al. for at least the reasons given with regard to claim 43.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 43, 44, 47-60, and 79 under 35 U.S.C. § 103(a) based on D'Amico et al., Jordan, and Hluchyj et al.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., JORDAN, HLUCHYJ ET AL., AND FACCINN ET AL.*

In paragraph 10 of the Office Action, the Examiner rejected claims 45 and 46 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Jordan, Hluchyj et al., and Faccinn et al. Applicants respectfully traverse the rejection.

Claims 45 and 46 depend from claim 43. Without acquiescing in the Examiner's rejection with regard to claims 45 and 46, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al., Jordan, and Hluchyj et al. identified above with regard to claim 43. Therefore, claims 45 and 46 are patentable over D'Amico et al., Jordan, Hluchyj et al., and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 43.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) based on D'Amico et al., Jordan, Hluchyj et al., and Faccinn et al.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of the application and the timely allowance of pending claims 1-64, 66-68, and 75-80.

As Applicants' remarks with respect to the Examiner's rejections overcome the rejections, Applicants' silence as to certain assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants

that such assertions are accurate or such requirements have been met, and Applicants reserve the right to dispute these assertions/requirements in the future.

If the Examiner believes that the application is not now in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned to discuss any outstanding issues.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,
HARRITY SNYDER, LLP

By: /Paul A. Harrity/
Paul A. Harrity
Reg. No. 39,574

Date: October 10, 2006

11350 Random Hills Road
Suite 600
Fairfax, Virginia 22030
(571) 432-0800

Customer Number: 25537